REMARKS

Applicants respectfully request reconsideration and reexamination of this application.

The title of the invention has been amended to more clearly reflect the elected subject matter. In addition, claims 24 and 25 have been cancelled, without prejudice, and the subject matter of these claims has been incorporated into new claims 32 and 33. Finally, claim 23 has been amended to more clearly state applicants' invention. As the foregoing amendments do not introduce any new matter, it is respectfully requested that they be entered by the Examiner.

Applicants affirm the election of claims 23-25, drawn to methods of producing antibodies, without traverse.

Claims 23-25 were rejected under 35 U.S.C. § 101 because the claimed methods allegedly lack patentable utility. Applicants respectfully traverse this ground of rejection.

The Examiner stated that

> [t]he specification fails to provide substantive evidence of a patentable utility for the method of producing antibodies. The specification speculatively claims that the antigens expressed from the J19 clone can be used in a vaccine composition. However, the specification fails to provide in vivo human data that indicates that the claimed method actually induces significant clinical effects.

See page 4, lines 3-9 of Paper No. 4.

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It is courteously noted that antibodies produced by the claimed methods can be used to screen for recombinantly produced antigenically competent fusion proteins. See page 13, lines 30-33 of the specification.

All that is required to satisfy 35 U.S.C. § 101 is some utility. See E.I. duPont de Nemours & Co. v. Berkley & Co., 205 U.S.P.Q. 1, 10 n.17 (8th Cir. 1980) ("a small degree of utility is sufficient. The claimed invention must only be capable of performing *some* beneficial function. An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks perfection or performs crudely. . . . Nor is it essential that the invention accomplish all its intended functions . . . partial success being sufficient to demonstrate patentable utility . . ." (emphasis in original, citations omitted). See also Envirotech Corp. v. Al George, Inc., 221 U.S.P.Q. 473, 480 (Fed. Cir. 1984) ("the defense of non-utility cannot be sustained without proof of total incapacity.").

As applicants' use of the antibodies produced by the claimed methods satisfies the statutory minimum requirement of "some" utility, the withdrawal of this ground of rejection is courteously requested.

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The specification was objected to and claims 23-25 were rejected under 35 U.S.C. § 112, first paragraph, as the specification as originally filed does not provide support for the invention as now claimed. Applicants respectfully traverse this ground for rejection.

The Examiner stated that

> the specification does not set forth the steps of the claimed method, i.e. the step of raising antibodies against the antigen.

See page 6 of Paper No. 4.

As techniques of producing antibodies were known in the art at the time the claimed invention was made, specific descriptions of such techniques are not required to enable the present invention. See In re Strahilevitz, 212 U.S.P.Q. 561, 564 (C.C.P.A. 1982).

In Strahilevitz, the appellant was claiming an invention relating to methods and devices for removing a hapten, antigen, or antibody from the blood of a living mammal. In relying on known prior art techniques of hemodialysis or hemoperfusion with immunochemical adsorption, the appellant "properly [relied] on literature citations to establish both the level of ordinary skill in the art and the fact that the techniques necessary to practice his invention were known in the art." Strahilevitz at 564. See also M.P.E.P. § 608.01(p).

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Similarly, techniques for producing antibodies to specific antigens were well known in the art at the time the claimed invention was made. For example, preparation and isolation of antibodies, including monoclonal antibodies, is described by Galfre et al., "Preparation of Monoclonal Antibodies: Strategies and Procedures," Methods in Enzymology, 73, 3-46 (1981) (Exhibit 1). General techniques for antibody production are described by Hurn et al., "Production of Reagent Antibodies," Methods in Enzymology, 70, 104-142 (1980) (Exhibit 2), and H. Eisen, Immunology: An Introduction to Molecular and Cellular Principles of the Immune Responses, 436-443 (Harper & Row, Philadelphia, 1980) (Exhibit 3). Accordingly, techniques for producing antibodies were well known in the art at the time the claimed invention was made, and thus this information need not be described in the specification to enable the claimed invention.

Continuing, the Examiner stated that

> the claimed priority documents fail to set forth a method of eliciting antibodies using the antigen(s) encoded by the J19 clone. Accordingly, the effective filing date of the elected claims is that of the instant application (April 27, 1993).

See pages 6-7 of Paper No. 4. Applicants courteously disagree with the Examiner.

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The present application is a continuation of U.S. application Serial No. 07/499,210, filed March 19, 1990, which is a continuation of application Serial No. 06/771,230, filed August 30, 1985. The disclosure of the present application is identical to Serial No. 06/771,230.

In addition, applicants claim priority of Great Britain application Serial No. 84 23659, filed September 19, 1984. Filed herewith is a Claim for Priority, noting that applicants claim priority of GB 84 23659. The disclosure of GB 84 23659 is identical to the present application.

Support for producing antibodies was described above in response to the rejection of claims under 35 U.S.C. § 101. Accordingly, applicants are entitled to their claimed priority date of September 19, 1984, and the specification is enabling for the claimed invention. As such, the withdrawal of this ground of objection to the specification and rejection of the claims is courteously requested.

Claims 23-25 were rejected under 35 U.S.C. 102(b) as being allegedly anticipated by any one of Robey et al., Proc. Natl. Acad. Sci. USA, 83, 7023-7027 (1986), Rusche et al., Proc. Natl. Acad. Sci. USA, 84, 6924-6928 (1987), Lasky et al., Science, 233. 209-212 (1986), Chanh et al., The EMBO Journal, 5, 3065-3071 (1986), or Putney et al., Science, 234, 1392-1395 (1986).

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As noted above, applicants claim and are entitled to priority of GB 84 23659, filed September 19, 1984. As Robey et al., Rusche et al., Lasky et al., Chanh et al., and Putney et al. were all published after applicants' claimed priority date of September 19, 1984, these references are not available as prior art against this application. Accordingly, the withdrawal of this ground for rejection is respectfully requested.

Applicants respectfully submit that this application is now in condition for allowance. Reconsideration and reexamination of this application, and allowance of the pending claims at the Examiner's convenience, are respectfully requested.

If there are any fees due in connection with the filing of this Amendment, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 9, 1994

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